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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,560	03/08/2002	Ernesto E. Blanco	217395US25CIP	2081

22850 7590 01/16/2007  
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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MACNEILL, ELIZABETH

ART UNIT	PAPER NUMBER
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3767

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

8

<b>Office Action Summary</b>	Application No. 10/092,560	Applicant(s) BLANCO, ERNESTO E.	
	Examiner Elizabeth R. MacNeill	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 17-20, 22-25, 27, 31-50, 91, 96-238 and 240-260 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-20, 22-25, 27, 31-50, 91, 96-238 and 240-260 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/13/06; 7/28/05; 8/17/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is in response to applicant's amendments submitted 1 November 2006.

#### ***Allowable Subject Matter***

1. The indicated allowability of claims 5-15, 17-20, 22-25, 27,31,34-50, 91-112, 119-121, 127-142, 145,146,148-150, 153, 156, 157,159, 160, 162,164-211, 218, 221, 227, 231-235, 245-248, 253, 254,256,257, and 260 is withdrawn in view of the newly discovered reference(s) to Danks et al (US 5,868,773). Rejections based on the newly cited reference(s) follow.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-4, 32, 33, 113-118, 122-126, 143, 144, 147, 151,152, 154, 155, 158, 161,163, 212-217, 219, 220, 222-226, 228-230, 236-238, 240-244, 249-252, 255, 258 and 259 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendments made to these recite the limitation "a cylinder penetrator attached to said handle which includes a cannula and an obturator slidably mounted in said cannula". There is no recitation of an obturator in the specification. Additionally, the "cannula" of the specification is defined as element 2,

which holds the tissue expanders 4, not the substantially planar blade as recited further in the claims. Rather, penetrator hollow cylinder 13 carries the planar blades and hollow stem 17 carries the blade guards 3a. For the purposes of examination, element 13 will be interpreted as the cannula in the claims, while element 17 will be interpreted as the obturator in the claims.

### ***Claim Objections***

4. Claim 145 objected to because of the following informalities: there is no antecedent basis for "the insufflation passageway". Appropriate correction is required.

### ***Double Patenting***

5. The applicant's assistance is requested in eliminating the duplicate claims in the present application. The applicant is reminded that dependent claims may be substantial duplicates of independent claims if the dependent claim requires all the limitations of the independent claim. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-15, 17-20, 22-25, 27,31-50, 91,96-238, 240-260 are rejected under 35 U.S.C. 102(b) as being anticipated by Danks et al (US 5,868,773).

Danks teaches a surgical device comprising a handle (40) with side horns (shown in Figures 7A and 7B) configured to be gripped; a cylinder penetrator which includes a cannula (18) and an obturator (15) slidably mounted in the cannula; and a substantially planar blade (81) mounted on the cannula; and a guard (51) mounted on the obturator; and an insufflation passageway (14); and a tissue expander (68); a locking mechanism (48). See Figures 2A and 5A-5D.

As to the cutting blade see Figures 5A-5D. It is also disclosed that "the blade 81 may have slight convex or concave curve" which would constitute a rounded tip (also see 78).

As to the blade guard see Figure 5D which shows guard 51 covering the distal tip of the blade and the edges of the blade, as well as having an edge angle which is smaller than the blade edge angle; see Figure 2A for the spring (21) (claims 17, ) which pushes the guard

As to the insufflation and gas reservoir see the Abstract.

As to the check valve see Fig 2A, elements 43 and 38

As to the penetration monitor see Fig 2A for trigger 48, which can act as a penetration monitor to determine if the guard is locked or unlocked.

As to the locking mechanism see Fig 2A for element 48.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-15, 17-20, 22-25, 27,31-50, 91,96-238, 240-260 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth R. MacNeill whose telephone number is (571)-272-9970. The examiner can normally be reached on 7:00-3:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Elizabeth MacNeill*  
ERM  
1/4/07

KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER

*Kevin C. Sirmons*